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REMARKS

By the present Amendment, claims 60, 61 and 65 have been amended for clarity to make these dependent claims consistent with the independent claim from which they depend.

In the Office Action, the Examiner has rejected claims 45, 46, and 56-65 under 35 U.S.C. § 103(a) as being unpatentable over the Grimm et al. UK Patent No. 2182857 in view of the Bersted et al. U.S. Patent No. 5,945,215. The Grimm et al. '857 reference discloses a cuddly toy in the shape of a teddy bear that has a pile which can be groomed by brushing or combing. The teddy bear disclosed in the Grimm et al. '857 reference is said to have an outer surface with a pile formed from strands of acrylic silver knit fabric. These types of toys were well known prior to Applicants' invention. They are not, however, the types of animal toys that are described in the Background to the Invention in this application or as set forth in the claims.

The Bersted et al. '215 patent discloses polypropylene polymer fibers having a unique crystalline microstructure as determined by a small angle x-ray defraction in the fibers and yarns. These fibers and yarns are said to exhibit improved recovery from compression and bending and are suitable for a wide range of applications including geotextile, apparel and upholstery fabrics, carpet yarns and other textile products. Bersted et al. '215 further discloses melt spinning of these fibers and further in column 31, lines 8-13 that:

The polypropylene polymer resin used for spinning fibers also can contain various additives and modifiers. Examples include pigments, processing aides, heat and light stabilizers, flame retardants, antimicrobials agents, nucleating agents and electrically conductive materials. Specific materials for various purposes are well known to persons skilled in the art and are discussed above.

There is no other disclosure in 48 plus columns of disclosure and approximately two columns of claims of Bersted et al. '215 of the use of an antimicrobial agent in these fibers. It is noted that the application for the Bersted et al. '215 patent was filed on September 12, 1997 and is related to a provisional application that was filed on September 16, 1996. Applicants claim priority of provisional patent application No. 60/043,014, filed April 15, 1997, which discloses

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the subject matter of the claims in this application on pages 67-82 thereof. Thus, Applicants' priority of this application predates the filing date of the Bersted et al. '215 but not the priority date thereof. It is not clear at this time whether the Bersted et al. '215 is an appropriate reference under 35 USC § 103 (a) to the extent that it incorporates the provisions of 35 USC § 102 (e).

Incorporation of antimicrobial agents into carpet fibers is known. However, there is no prior art disclosure known to Applicants that antimicrobial agents can be applied to pet products that are disclosed and claimed the present application.

As disclosed in the Background for Applicants' invention beginning on page 1,

The prior art amusement articles, (textile based outer material and a filler material) do not include a microbe-inhibiting agent or property, therefore, do not address the problems that can arise if microbes are allowed to grow or proliferate on, within or around the articles. A damp environment often encourages the proliferation of microbes. Because it is common for pets, especially for dogs, to salivate upon, deposit partially digested food upon, urinate upon, or otherwise soil their amusement articles; and because such articles are generally porous and absorbent, microbial proliferation is especially problematic. The fact that the articles can remain in favorable incubation temperature (e.g., in a dogs mouth or close to a dogs body while sleeping) further aggravates the problem. These conditions can also make the articles attractive to other pests such as fleas and ticks. Pets using articles, as well as their owners, can thus be exposed to an increased health hazard. The environment to which such articles are exposed is unique: and the difficulty in designing a product which is efficacious, safe, non-toxic and economical is not easy to produce. These factors may explain why amusement articles for pets have not included a microbe-inhibiting agent or property.

The combination of Grimm '857 and Bersted et al. '215 is traversed. There is no basis for making the alleged combination. The disclosure of an antimicrobial compound in the Bersted et al. '215 reference is incidental at best. There is no teaching as to how anti-microbial agents could be incorporated into the Grimm et al. '857 article. The combination is clearly made with hindsight reconstruction, with Applicants' claims as a guide, and not by any suggestion of the two references. Contrary to the Examiner's representation, Bersted et al. '857 does not teach anti-microbial agents applied to a textile casing.

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The Bersted et al. '857 references does not teach the use of polypropylene polymer fibers and yarns made according to the '215 patent used in animal products or even in artificial fleece products. Polypropylene fibers are principally used in carpet fibers but can also be used in upholstery apparel and geotextile fibers.

The Examiner represents that it would have been obvious to a person of ordinary skill in the art at the time the invention is made to modify the "apparatus" of Grimm et al. with a microcidal agent in view of the teaching of Bersted et al., in order to reduce the occurrence of bacteria on the article. However, both references are silent as to the need to reduce the occurrence of bacteria on the article. Neither of the references recognizes the long felt need set forth above and disclosed in the background for Applicants' invention. There is no disclosure in either of the references of the problem to be solved. Thus, there would be no motivation for solving an unknown or unrecognized problem by combining two drastically unrelated references.

The standard for combining references in a patentability analysis under 35 U.S.C. § 103(a) is set forth recently in the case *In re Sang-Su Lee* 277 F.3d 1338; 61 USPQ2d (BNA) 1430 at pages 1342-1344 as follows:

As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Graselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp., v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion,

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teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding') (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of the ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In view of the foregoing, it would not have been obvious to combine the at best incidental teaching of the Bersted et al. '215 reference with the Grimm '857 disclosure. The Examiner has given no explanation of how the teaching of Bersted is suggested for use in the Grimm '857 teddy bear. Nor has the Examiner explained how the disclosure in the Bersted et al. '215 patent could be used in the fleece article of the Grimm '857 patent. Thus, the alleged combination of Bersted et al. '215 with the Grimm '857 reference is inappropriate to meet claims 45, 46, and 56-65.

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However, even if the alleged combination of Bersted et al. '215 and Grimm '857 were made, however untenably, it still would not reach Applicants' claimed invention. At best, the alleged combination would incorporate into the Grimm et al. fleece some fibers which have been some antimicrobial agents (of undefined nature and of undefined concentrations). It is not clear whether the polypropylene fibers of Bersted et al. '215 would be incorporated into the fleece or would be otherwise incorporated into other portions of the teddy bear or to what extent the fibers would be incorporated into either. There is a clear lack of enabling disclosure to make the alleged combination. Contrast the stark disclosure in Bersted et al. '215 with the extensive enabling disclosure in Applicants' written description of the invention.

All of the claims distinguish over the alleged combination of Grimm '857 and Bersted et al. '215 in calling for an effective amount of a microcidal agent applied to a textile casing. This element is not present in the alleged combination of Grimm '857 and Bersted et al. '215 in any enabled form. All of the claims further distinguish over the alleged combination of Grimm '857 and Bersted et al. '215 in calling for an outer textile casing formed of a tough, chew-resistant material. There has been no disclosure that the Grimm '857 teddy bear is formed from a tough, chew-resistant material. From a reading of the Grimm '857 patent it appears that it is made for a child and not for an animal who would chew the toy. Further, claims 45, 46 and 61-65 call for the micro-cidal agent to be non-toxic and non-carcinogenic when ingested by domestic animals at the levels used in the amusement article. This feature is not found in the alleged combination of Bersted et al. '215 and Grimm '857.

In addition to the foregoing, claim 60 calls for the outer textile fabric to be treated with a compound to impart at least one low surface energy, non-hydrophilic, antistatic property and anti-adhesion property. This concept is not disclosed in any alleged combination of references.

Claim 64 further calls for the textile based amusement article to include an odor-absorbing agent selected from one of activated carbon and a zeolite compound. This element is not disclosed in the alleged combination of Bersted et al. '215 and Grimm '857.

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Likewise, claim 65 calls for the outer casing to be impregnated with a flame resistant modacrylic polymer. This element is also not disclosed in the alleged combination of Bersted et al. '215 and Grimm '857.

It is to be noted that specific microbe-cidal agents are claimed in claims 56-58. These agents are not disclosed in any alleged combination of Grimm '857 and Bersted et al. '215. The examiner's unsupported bald statement that these specific compounds are obvious does not supplant the requirement that the Patent Office show why these specified compounds are believed to be obvious. Still further, claims 61-63 call for the microb-cidal agent to comprise a microbe-impenetrable laminate on an inner surface of the outer fabric layer. Claim 63 calls for the microbe-cidal agent to be applied to or incorporated into the thermoplastic film or latex polymer. These limitations are not disclosed in any alleged combination of Grimm '857 and Bersted et al. '215.

In view of the foregoing remarks and amendments, it is submitted that the claims are in condition for allowance. Early notification of allowability is respectfully requested.

Respectfully submitted,

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